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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,131	01/26/2001	Satoshi Mizutani	2309/01213	6716

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DARBY & DARBY P.C.
805 Third Avenue
New York, NY 10022

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 03/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Applicati n N .

09/771,131

Applicant(s)

MIZUTANI ET AL.

Examin r

Alicia Chevalier

Art Unit

1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-7 and 10-12.Claim(s) withdrawn from consideration: 8 and 9.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: It remains the Examiner's position that claims are unpatentable for reasons previously of record in the final office action, paper #10 filed January 2, 2003.

Applicant's arguments filed in response to the final office action dated January 2, 2003, paper #10, regarding the rejections of record have been carefully considered but are deemed unpersuasive.

Applicant traverses the rejection over Sorenson (4,327,730) in view of Gray (5,660,788) because Applicants assert that Sorenson's nubbles do not substantially alter the macroscopic profile of the film. The limitations on which Applicant relies (i.e. substantially alter the macroscopic profile of the film) are not stated in the claims. Claim 1 recites, "the height of each protrusion from the body facing surface is larger than that of each fine convex portion therefrom," which is repeated in claims 11 and 12. Since the only requirement of the protrusions (i.e. nubbles) is that they are larger than the fine convex portion, it is irrelevant whether Sorenson's nubbles substantially alter the macroscopic profile of the film or not as long as they are larger than the fine convex portion. It is further noted that the independent claims 1, 11 and 12 do not have limitations directed to the precise size difference between the fine convex portion and the protrusions. Therefore, as long as the protrusions are at least 0.05 μm larger than the convex portion the claim limitation is satisfied.

Applicant further argues that it is not the main intent of Sorenson to avoid the plasticky, sticky feeling associated with wearing an absorbent article when it is wet, as is the case with the present invention. First, the limitations on which Applicant relies (i.e. avoids a sticky feeling) are not stated in the claims. Second, the phrase "to avoid the plasticky, sticky feeling associated with wearing an absorbent article when it is wet" is an intended use. It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. Third, Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness."). See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration.

Applicant argues that in order to avoid such plasticky, sticky feelings, the present invention requires the claimed protrusions to project beyond the top of the convex portion without causing any buckling. As noted above, the independent claims 1, 11 and 12 do not have limitations directed to the precise size difference between the fine convex portion and the protrusions.


Applicant argues that Sorenson has nubbles formed over a tapered surface of the tapered capillary structure, which does not correspond to perforation 4 in the claimed invention. Claim 1 recites "a top sheet including a number of perforations," which is also repeated in claims 11 and 12. Although, Sorenson includes additional structure not required by Applicant's invention, it must be noted that Sorenson discloses the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant. It is noted that Sorenson's capillary structure is perforated at the apex, thus it reads on Applicant's claim limitation "number of perforations."

Applicant's arguments regarding the size of the capillary structure to the size of the nubbles in Sorenson is confusing. The Examiner is unclear about why the size of the capillary being larger than the size of the nubble makes a difference.

Applicant argues that the particulate material in Gray may achieve an effect, which is nothing more than the nubbles discloses in the Sorenson patent. Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. Furthermore, it is noted that combination of Gray and Sorenson disclose all the limitations of the instant claimed invention. The fact that the "effect" of the combination is different than Applicant's claimed invention is irrelevant since it meets all the structural limitations of the claims. Also, the fact that Applicant uses the projections on fine convex portions for a different purpose does not alter the conclusion that its use in a prior art device would be prima facie obvious from the purpose discloses in the reference.

Applicant asserts that the combination of Sorenson, Gray and McCormack (5,955,187) would fail to arrive at the invention as set forth in the independent claims. 37 CFR § 1.111 (b) states, "a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the references. 37 CFR § 1.111(c) requires Applicant to "clearly point out the patentable novelty which he/she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He/she must also show how the amendments avoid such references or objections." In this case, Applicant has failed to clearly point out patentable novelty and failed to show how the amendment avoids the combination of references applied against the claim.

In conclusion Applicant's has done piecemeal analysis of the references. It has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. In re Keller, 208 USPQ 871 (CCPA 1981). Furthermore, Applicant has not clearly pointed out how the claim language patentably distinguishes it self over the prior art of record.


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1172

3/17/03